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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,005	09/22/2003	Matthias Krull	2000DE402/D	1909
25255	7590	09/11/2006		
CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205			EXAMINER TOOMER, CEPHIA D	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,005

Applicant(s)

KRULL ET AL.

Examiner

Cephia D. Toomer

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 6/22/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3,5-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3,6-9,11 is/are rejected.
- 7) ☐ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment filed June 22, 2006 in which claim 1 was amended.

The nonstatutory obviousness-type double patenting rejection is withdrawn in view of Applicant filing a terminal disclaimer.

The rejection of the claims under 35USC 112, second paragraph is withdrawn in view of the amendment to the claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6, 7, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 2,242,474 in view of EP 680 506.

CA teaches a flow improver composition for mineral oils comprising a terpolymer of 65 to 94 mol% ethylene, 1-25 mol% of a neocarboxylic acid and 5-35 mol% vinyl acetate (see abstract and claim 1). The terpolymer has a melt viscosity at 140 C of from 20 to 10000 mPas (see page 7, lines 28-29). The mineral oil may be gas oil, diesel oil or heating oil (see page 1, lines 10-25).

CA teaches that the flow improver composition may contain a paraffin dispersant, a comb polymer, such as fumarate vinyl acetate copolymers (see page 9, lines 24-31).

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The mixing ratio of the terpolymer to comb polymer is 1:10 to 20:1 (see page 10, lines 5-6). CA teaches that conventional additives may be included in the flow improver composition. Such additives include lubricity enhancers. CA teaches the limitations of the claims other than the oil-soluble amphiphile. However, EP 680506 teaches this difference.

EP 680506 teaches a fuel oil composition comprising a lubricity additive (see page 2, lines 3-4). The lubricity additive comprises an ester of a carboxylic acid and an alcohol wherein the acid has from 2-50 carbon atoms and the alcohol has one or more carbon atoms (see page 2, lines 36-39). An example of the additive includes glycerol monooleate (see page 4, line 55). EP 680506 teaches that middle distillate cold flow improvers may be included in its fuel (see page 4, lines 43-46).

It would have been obvious to one of ordinary skill in the art to include the lubricity additive in the fuel oil composition because CA especially desires a lubricity additive and the additive would perform its attendant function.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over CA 2242474 in view of EP 680506 as applied to claims above, and further in view of Davies (US 6,010,545).

CA and EP have been discussed above. The references fail to teach that the lubricity additive is a fatty acid. However, Davies teaches that esters such as those disclosed in EP 680 506 may be replaced with one or more carboxylic acids (see col. 6, lines 18-21; col. 5, lines 42-55).

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It would have been obvious to one of ordinary skill in the art to include fatty acid lubricity additives because Davies teaches that they are art recognized equivalents of the esters of these fatty acids.

4. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the flow improver of CA 474 is not identical to Applicant's flow improver.

The examiner agrees. However, the proportions for the monomers of CA 474 overlap those of the present invention and render the claimed terpolymer *prima facie* obvious.

Applicant argues that EP 506 is a broad general reference which states that lubricity additives may be used with any type of additive, but that EP 506 is silent on any impact of such a combination on filterability or lubricity. Applicant argues that unexpected results are obtained with the combination of the terpolymer and amphiphilic component.

Applicant's data have been considered but are not deemed to constitute unexpected results. The showings are not commensurate in scope with the claims. The examples are directed to specific compounds and specific proportions, whereas the claims read on hundreds of combinations of the compounds and proportions. The examiner cannot ascertain if unexpected results are obtained.

5. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

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claim and any intervening claims. The prior art fails to teach or suggest that component A) is a fatty acid alkanolamine or fatty acid alkanoamide.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cepha D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cephia D. Toomer
Primary Examiner
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